

ESTTA Tracking number: **ESTTA110685**

Filing date: **11/20/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	California Western School of Law		
Entity	Corporation	Citizenship	California
Address	225 Cedar Street San Diego, CA 92101 UNITED STATES		
Attorney information	Tawnya R. Wojciechowski TRW Law Group 19900 MacArthur Boulevard, Suite 1150 Irvine, CA 92612-8433 UNITED STATES tawnya@trwlawgroup.com Phone:949-701-4747		

Registration Subject to Cancellation

Registration No	2383328	Registration date	09/05/2000
Registrant	ELMHURST COLLEGE 190 Prospect Avenue Elmhurst, IL 60126 UNITED STATES		
Goods/Services Subject to Cancellation	Class 041. First Use: 1999/03/29 , First Use In Commerce: 1999/03/29 Goods/Services: EDUCATIONAL SERVICES, NAMELY PROVIDING COURSES OF INSTRUCTION AT THE UNDERGRADUATE LEVEL		
Grounds for Cancellation	The registered mark has been abandoned.		

Attachments	Petition for Partial Cancellation - Elmhurst College.pdf (2 pages)(14722 bytes)
Signature	/trw/
Name	Tawnya R. Wojciechowski
Date	11/20/2006

THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Registration No.: 2383328

California Western School of Law, a California
corporation

Petitioner,

v.

Elmhurst College, an Illinois corporation

Registrant

Cancellation No.: N/A

PETITION FOR PARTIAL
CANCELLATION

November 20, 2006

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION FOR PARTIAL CANCELLATION

Petitioner California Western School of Law. (“Petitioner”), a California corporation, located at 225 Cedar Street, San Diego, California 92101, believes that it is being damaged by Registration No.:2383328 and hereby petitions to cancel same on the following grounds:

1. Upon information and belief, Registrant, Elmhurst College (“Registrant”), an Illinois corporation doing business at 190 Prospect Avenue, Elmhurst, Illinois, is the owner of United States Trademark Registration No. 2383328, registered September 5, 2000 for the mark WHAT COLLEGE OUGHT TO BE.. for “educational services, namely providing courses of instruction at the undergraduate level” in International Class 41, claiming a date of first use of March 29, 1999.
2. Petitioner is the owner of United States Trademark Application Serial No. 78/596999 for WHAT LAW SCHOOL OUGHT TO BE, and United States Trademark Application Serial No.: 78/597025 for the phrase LEX LATA, LEX FERENDA, LEX (SCHOLA) FERENDA, both for “Educational services, namely, conducting graduate-level classes, seminars, conferences, and workshops in the field of legal education; providing post-graduate educational classes, course of instruction, seminars, conferences and workshops in the field of law, all excluding undergraduate courses of instruction; law school alumni programs and services, namely conducting sporting and cultural events for law school alumni, in International Class 41.”

in International Class 41 (as amended). The phrase LEX LATA, LEX FERENDA, LEX (SCHOLA) FERENDA translates from Latin into English as “What the law is, what the law ought to be, what law school ought to be.”

3. Petitioner has received a final office action from the United States Patent and Trademark Office denying its application Serial No.: 78/596999 on the basis that the prior registrations owned by Registrant are likely to be confused with Applicant’s mark, and as such, has standing to bring this cancellation action.
4. Petitioner has also received a non-final office action issued for Serial No.: 78/597025, and if a final office action is received for this application, Petitioner will move to consolidate a petition to partially cancel the above registration in this proceeding for the convenience of the Board and the parties.
5. On information and belief, Applicant does not believe that Registrant offers or uses the registered mark on services which are competitive or related to Applicant’s and as such, Applicant requests that Registrant’s mark under U.S. Registration No.: 2383328 be partially cancelled to exclude the services identified in Applicant’s pending application. As such, Applicant, on information and belief, asserts that Registrant does not own or has abandoned any right to such services.
6. Upon information and belief, Registrant has abandoned the registered mark for the services set forth in Applicant’s pending application and it has discontinued use of the mark with intent not to resume such use.

WHEREFORE, Petitioner believes that it will be damaged by Registration No. 2383328 and prays that this Petition for Partial Cancellation be sustained in favor of Petitioner, that judgment be entered against Registrant and that U.S. Trademark Registration No. 2383328 be partially canceled to exclude the services set forth in Application Serial No.: 78/596999.

Respectfully submitted

TRW LAW GROUP

Date: November 20, 2006

_____/s/_____
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